

ESTTA Tracking number: **ESTTA582330**

Filing date: **01/16/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206761
Party	Plaintiff University Athletic Association
Correspondence Address	ROSALEEN H. CHOU KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE STREET, SUITE 2800 ATLANTA, GA 30309 UNITED STATES rchou@ktslaw.com, chenn@ktslaw.com, kteilhaber@ktslaw.com, tmadmin@ktslaw.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Rosaleen H. Chou
Filer's e-mail	rchou@ktslaw.com, chenn@ktslaw.com, kteilhaber@ktslaw.com, tmadmin@ktslaw.com
Signature	/Rosaleen H. Chou/
Date	01/16/2014
Attachments	2014.01.16 Opposers Trial Brief.pdf(625701 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UNIVERSITY ATHLETIC)	Opposition 91206761
ASSOCIATION, INC.,)	
)	
Opposer,)	In the matter of Application
)	Serial No. 85/480,582
v.)	for the mark GATOR SHOP
)	
INCENTIVE MARKETING, INC.,)	
)	
Applicant.)	
)	

OPPOSER’S TRIAL BRIEF

R. Charles Henn Jr.
Rosaleen H. Chou
KILPATRICK TOWNSEND & STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500

Attorneys for Opposer

TABLE OF CONTENTS

I.	SUMMARY OF ARGUMENT	1
II.	LEGAL ISSUES PRESENTED	1
III.	DESCRIPTION OF THE TRIAL RECORD.....	2
A.	Evidence Submitted by the University of Florida.....	2
B.	Evidence Submitted by the Gator Shop	3
C.	Evidence Automatically of Record Pursuant to 37 C.F.R. 2.122(B)(1)	3
IV.	RECITATION OF FACTS	3
A.	The University of Florida’s Well-Known GATORS Marks.....	3
1.	The University’s Adoption of its GATORS Mark in 1906.....	3
2.	The University’s Use of its GATORS Marks In Connection With Retail Store Services and Other Goods and Services	6
3.	The University Owns Multiple Prior Issued Registrations for its GATORS Marks, Several of Which Are Incontestable	8
4.	The GATORS Marks are Widely and Exclusively Associated with the University	10
a.	The University’s Print Advertising.....	10
b.	The University’s Television Advertising	11
c.	The University’s Internet Advertising	12
5.	The University Has Sold Well Over \$ 1 Billion Dollars Worth of Goods and Services Under the GATORS Marks	13
6.	The University’s GATORS Marks Have Received Extensive Media Attention	13
7.	The Public Associates the University’s GATORS Marks with the University	16
B.	The University’s Well-Known Orange-and-Blue Color Mark	17
C.	Applicant and Its GATOR SHOP Mark	18
V.	ARGUMENT	24
A.	The University Has Standing	24

B.	The University Has Priority	24
1.	The University Has Priority Based On Its 12 Pleaded Registrations Covering Retail Store Services, Entertainment Services, and Apparel	25
2.	The University Has Priority Based on Its Common Law Use Before Applicant’s Alleged First Use Date of 1984.....	26
3.	The University Has Priority Based on Its Common Law Use Before Applicant’s Filing Date in 2011.....	27
C.	Likelihood of Confusion Exists Between the University’s GATORS Marks and the GATOR SHOP Mark	27
1.	The University’s GATORS Marks Are Strong and Entitled to Broad Protection.....	28
2.	The Services at Issue Are Identical.....	32
a.	The University’s Incontestable Registration No. 1222098 for GATORS Claiming a Date of First Use of 1955 and Common Law Rights Cover Identical Retail Store Services.....	32
b.	The University’s Numerous Pleaded Registrations and Common Law Rights Predating Applicant’s Alleged First Use Date of 1984 Cover Closely Related Goods and Services.....	33
3.	The Parties’ Marks Are Similar in Appearance, Connotation, and Commercial Impression	34
4.	The Parties’ Channels of Trade and Customers Overlap	37
5.	Actual Confusion Between Applicant’s GATOR SHOP Mark And the University’s GATORS Marks	39
6.	The Gator Shop Adopted Its Mark With Knowledge of The University’s Rights in Its GATORS Marks and With The Intent to Trade Off The Goodwill Associated with The University’s GATORS Marks.....	40
7.	Any Doubt Must be Resolved Against the Gator Shop	42
D.	The Gator Shop Mark Falsely Suggests a Connection With the University in Violation of Section 2(a) of the Lanham Act.....	43
VI.	CONCLUSION.....	45

TABLE OF AUTHORITIES

Cases

<i>Am. Scientific Chem., Inc. v. Am. Hosp. Supply Corp.</i> , 690 F.2d 791 (9th Cir. 1982)	30
<i>Avenza Sys. Inc. v. Avencia Inc.</i> , Cancellation No. 92046736, 2009 WL 4086592 (T.T.A.B. Sept. 29, 2009)	31
<i>Bd. of Supervisors of La. State Univ. v. Smack Apparel Co.</i> , 438 F. Supp. 2d 653 (E.D. La. 2006)	30, 41, 42
<i>Bd. of Trs. of the Univ. of Ala. v. BAMA-Werke Curt Baumann</i> , 231 U.S.P.Q. 408, 411	45
<i>Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.</i> , 973 F.2d 1033, 24 U.S.P.Q.2d 1161 (2d Cir. 1992)	28
<i>Brown Shoe Co. v. Robbins</i> , 90 U.S.P.Q.2d 1752 (T.T.A.B. 2009)	25
<i>Buffett v. Chi-Chi's, Inc.</i> , 226 U.S.P.Q. 428 (T.T.A.B. 1985)	43
<i>Carl Karcher Enters. v. Stars Rest. Corp.</i> , 35 U.S.P.Q.2d 1125 (T.T.A.B. 1995)	34
<i>Century 21 Real Estate Corp. v. Century Life of Am.</i> , 23 U.S.P.Q. 1698 (Fed. Cir. 1992)	35
<i>Dan Robbins & Assocs., Inc. v. Questor Corp.</i> , 599 F.2d 1009 (C.C.P.A. 1979)	40
<i>E. & J. Gallo Winery v. Gallo Cattle Co.</i> , 967 F.2d 1280 (9th Cir. 1992)	28
<i>Grand Canyon West Ranch, LLC v. Hualapai Tribe</i> , 88 U.S.P.Q. 2d 1501 (T.T.A.B. 2008)	28
<i>Han Beauty, Inc. v. Alberto-Culver Co.</i> , 236 F.3d 1333 (Fed. Cir. 2001)	28
<i>Hewlett-Packard Co. v. Packard Press, Inc.</i> , 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002)	32, 37
<i>In re Dixie Rests.</i> , 105 F.3d 1405 (Fed. Cir. 1997)	34

<i>In re E.I. du Pont de Numours & Co.</i> , 476 F.2d 1357 (C.C.P.A. 1973)	27, 28
<i>In re Majestic Distilling Co.</i> , 315 F. 3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003)	38
<i>In re Mighty Leaf Tea</i> , 601 F.3d 1342 (Fed. Cir. 2010)	43
<i>In re Pix of Am., Inc.</i> , 225 U.S.P.Q. 691 (T.T.A.B. 1985)	35
<i>In re Sarjanian</i> , 136 U.S.P.Q. 307 (T.T.A.B. 1962)	35
<i>In re Sauer</i> , 27 U.S.P.Q.2d 1073 (T.T.A.B. 1993), <i>aff'd</i> , 26 F.3d 140 (Fed. Cir. 1994)	44
<i>In re Urbano</i> , 51 U.S.P.Q.2d 1776 (T.T.A.B. 1999)	44, 45
<i>In re White</i> , Serial No. 78175476, 73 U.S.P.Q.2d 1713, 2004 WL 2202268 (T.T.A.B. Sept. 8, 2004)	43, 45
<i>Kenner Parker Toys, Inc. v. Rose Art Indus.</i> , 963 F.2d 350 (Fed. Cir. 1992)	43
<i>Kos Pharm., Inc. v. Andrx Corp.</i> , 369 F.3d 700 (3d Cir. 2004)	40
<i>Lacoste Alligator S.A. v. Maxoly Inc.</i> , 91 U.S.P.Q.2d 1594 (T.T.A.B. 2009)	24, 36
<i>Miss Universe L.P. v. Cmty. Mktg., Inc.</i> , 82 U.S.P.Q.2d 1562 (T.T.A.B. 2007)	43
<i>Moore Bus. Forms, Inc. v. Ryu</i> , 960 F.2d 486 (5th Cir. 1992)	39
<i>Nina Ricci, S.A.R.L. v. E.T.F. Enters.</i> , 889 F.2d 1070 (Fed. Cir. 1989)	43
<i>Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> , 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005)	34

<i>Planters Nut & Chocolate Co. v. Crown Nut Co.</i> , 305 F.2d 916 (C.C.P.A. 1962)	37, 42
<i>Procter & Gamble Co. v. Conway</i> , 419 F.2d 1332, 164 U.S.P.Q. 301 (C.C.P.A. 1970)	36
<i>San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.</i> , 196 U.S.P.Q. 1 (C.C.P.A. 1977)	34
<i>Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.</i> , 748 F.2d 669 (Fed. Cir. 1984)	42
<i>Starbucks U.S. Brands LLC v. Ruben</i> , 78 U.S.P.Q.2d 1741 (T.T.A.B. 2006)	24, 34, 35, 37
<i>TBC Corp. v. Holsa, Inc.</i> , 126 F.3d 1470 (Fed. Cir. 1997)	40
<i>Times Mirror Magazines, Inc. v. Field & Stream Licenses Co.</i> , 294 F.3d 383 (2d Cir. 2002)	31
<i>Tyco Healthcare Group LP v. Ethicon Endo-Surgery, Inc.</i> , 587 F.3d 1375 (Fed. Cir. 2009)	31
<i>Ultratan Suntanning Ctrs. Inc. v. Ultra Tan Int’l AB</i> , 49 U.S.P.Q.2d 1313 (T.T.A.B. 1998)	25, 34
<i>Univ. of Ga. Athletic Ass’n v. Laite</i> , 756 F.2d 1535 (11th Cir. 1985)	30
<i>Univ. of Kan. v. Sinks</i> , 565 F. Supp. 2d 1216 (D. Kan. 2008)	41, 42
<i>Wilson v. Delaunay</i> , 245 F.2d 877 (C.C.P.A. 1957)	35
<i>World Carpets, Inc. v. Dick Littrell’s New World Carpets</i> , 438 F.2d 482 (5th Cir. 1971)	40
<i>Wynn Oil Co. v. Thomas</i> , 839 F.2d 1183 (6th Cir. 1988)	37
Statutes	
15 U.S.C. § 1052(d)	2
Other Authorities	
37 C.F.R. 2.122(B)(1)	3
Fed. R. Civ. P. 30(b)(6)	2, 39, 42

Rules

4 J. THOMAS McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:20 (4th ed. 2013)	37
---	----

I. SUMMARY OF ARGUMENT

The University of Florida (the “University”) adopted its famous GATORS mark in 1906 and has been continuously using the GATORS mark in connection with a wide variety of goods and services, including retail store services, athletic and entertainment services, clothing, hats, and merchandise, for decades. Building on its GATORS athletic identity, the University has used various marks consisting of or incorporating the term GATORS, as well as graphic depictions of alligators, to refer to the University, its athletic teams, students, fans, and alumni of the University (the University’s “GATORS Marks”). As a result of over 100 years of use and extensive news media attention during this time, the University’s GATORS Marks are well-known and strong, and the public immediately associates the GATORS Marks with the University. The University owns numerous incontestable registrations for its GATORS Marks covering various goods and services, including retail store services.

Despite the University’s undeniably strong rights in its GATORS Marks, Incentive Marketing dba Gator Shop (“Gator Shop”) filed a trademark application for the mark GATOR SHOP covering retail store services (the “GATOR SHOP Mark”). The Gator Shop is located directly across the street from the University that sells University of Florida-branded apparel and merchandise to fans of the University. The Gator Shop readily admits that it was aware of the University’s GATORS Marks prior to its alleged first use of the GATOR SHOP Mark in 1984 (nearly 30 years *after* the University’s first use date of its GATORS mark for retail store services). Moreover, the Gator Shop uses (without authorization) the University’s GATORS Marks, Orange-and-Blue Color Scheme, and other indicia of the University on its website, advertising, and product catalogs leveraging the goodwill of the GATORS Marks.

The parties’ marks are virtually identical, and the parties target identical customers with identical services that are marketed through identical channels of trade. Not surprisingly, numerous instances of actual confusion have occurred between the marks. For these reasons, the GATOR SHOP Mark should be refused registration under Sections 2(d) and 2(a) of the Lanham Act.

II. LEGAL ISSUES PRESENTED

A. Whether Applicant’s GATOR SHOP Mark so resembles Opposer’s GATORS Marks,

registered and used by Opposer for goods and services identical to Applicant's, so as to be likely to cause confusion, mistake or deception in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d); and

B. Whether Applicant's GATOR SHOP Mark falsely suggests a connection with Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

III. DESCRIPTION OF THE TRIAL RECORD

A. Evidence Submitted by the University of Florida

The University has filed the following Notice of Reliance and Notices of Filing of Testimony Depositions:

1. The University's **Notice of Reliance and Exhibits 1-19 (Opp's NOR 0001 - 0503)**, filed on August 2, 2013 as Docket No. 8, which includes the following evidence:
 - a. Trademark registrations owned by the University of Florida, for which printouts from the electronic database records of the USPTO showing the current status and title of the registrations are marked as **Exhibits 1 - 12 (Opp's NOR 0001 - 0108)**.
 - b. A true and correct copy of the April 11, 2013 discovery deposition of Applicant Incentive Marketing's Rule 30(b)(6) Designee Joseph Fincher ("Fincher Dep.") and the accompanying Exhibits 1-16, marked as **Exhibit 13 (Opp's NOR 0109 - 0325)**. The parties have stipulated that the discovery deposition of Applicant Incentive Marketing may be offered in evidence in the same manner as if it had been taken as a testimonial deposition during Opposer's Testimony Period. *See* Dkt. 5.
 - c. A true and correct copy of Opposer's First Set of Requests for Admission served on December 12, 2012, Applicant's Answers served on January 15, 2013, and Applicant's Supplemental Answers served on March 1, 2013, marked as **Exhibits 14 - 16 (Opp's NOR 0326 - 0487)**.
 - d. A true and correct copy of Opposer's First Set of Interrogatories served on December 12, 2012, Applicant's Responses served on January 15, 2013, and Applicant's Supplemental Responses served on March 1, 2013, marked as **Exhibits 17 - 19 (Opp's NOR 0488 - 503)**.
2. The University's **Notice of Filing of Testimony Deposition of Michael Drucker ("Drucker Dep.") and accompanying Exhibits 1-13 (Opp's NOR 0001 - 0233)**, filed on January 16, 2014 as Docket Nos. 20-21 ("NORT").¹

¹ Opposer's Notice of Filing of Testimony Deposition of Michael Drucker filed on August 16, 2013 (Dkt. 9-10) inadvertently did not include the deposition transcript. Upon discovery, Opposer filed a corrected version of its Notice of Filing of Testimony Deposition of Michael Drucker on January 16, 2014 (Dkt. 20-21).

3. The University's **Notice of Filing of Testimony Deposition of Debbie Gay ("Gay Dep.") and accompanying Exhibits 1-52 (Opp's NORT 0234 - 2222)**, filed on August 16, 2013 as Docket Nos. 11-18 ("NORT").

B. Evidence Submitted by the Gator Shop

The Gator Shop did not file a Notice of Reliance and has not made any additional evidence of record in this proceeding.

C. Evidence Automatically of Record Pursuant to 37 C.F.R. 2.122(B)(1)

1. The application file of U.S. Trademark Application Serial No. 85/480,582 for the GATOR SHOP mark ("GATOR SHOP App. File").

IV. RECITATION OF FACTS

A. The University of Florida's Well-Known GATORS Marks

1. The University's Adoption of its GATORS Mark in 1906

Located in Gainesville, Florida, the University of Florida was founded in 1853. Gay Dep. at 11:10-12:2. The University is the state's oldest and largest university and the second largest university in the United States by student population, enrolling approximately 49,000 students in the Fall of 2011. *Id.* The University offers undergraduate, graduate, and doctoral programs in a wide variety of disciplines and has consistently been ranked as one of the nation's top 50 public universities by *U.S. News & World Report*. *Id.* at 11:20-12:20, Ex. 2.

In 1906, the University adopted the mark GATORS as the athletic identity of the University. *Id.* at 28:8-16. The University's football team, which was first fielded in 1906, was known as the GATORS. *Id.* at 15:24-16:1, 28:8-16. In the early 1900s, the University also adopted an alligator as its mascot. *Id.* at 33:4-33:15, Ex. 19.

Since its adoption of the GATORS mark in 1906, the University has continued to build its identity around the GATORS mark and has used the GATORS mark in connection with a wide variety of goods and services associated with the University. Beginning as early as the 1910s, the University operated a student newspaper called *The Florida Alligator*. *Id.* at 29:11-30:5. In every issue of this newspaper to date, the University regularly referred to (and continues to refer to) its students, fans, and

athletic teams as the GATORS. *Id.* at 30:6-31:13, Ex. 16. For example, the headlines “Gators Flock to Uncle Sam’s Colors” and “Gators Smash Carolina Defense and Win Brilliant 21 to 13 Victory” from *The Florida Alligator* dated October 10, 1917 and October 17, 1917. *See id.*

Building on the University’s GATORS athletic identity, the University began using various marks consisting of or incorporating the term GATORS, as well as graphic depictions of alligators, to refer to the University, its athletic teams, students, fans, and alumni (the University’s “GATORS Marks”). Since as early as the 1920s to the present, the University’s football programs and media guides for its 21 athletic teams have prominently used the University’s GATORS Marks. *Id.* at 26:8-28:7, Exs. 14-15. The University’s GATORS Marks appear on almost every page of these programs and media guides, which have been distributed (and continue to be distributed) at every athletic game and printed annually. *Id.*



Since its adoption until 1957, the University’s GATOR mascot (the “GATOR Mascot”) consisted of various illustrations of an alligator, including the depictions below. *Id.* at 33:4-34:24, Exs. 19-20.



In 1957, a live alligator named “Albert” was introduced, which became the name of the University’s GATOR Mascot. *Id.*



Because having a live alligator as a mascot at athletic games can be complicated, the University introduced a plush version of Albert during the 1970s, which appears at every home game and other University-related events. The University later introduced a plush version of a female alligator in the 1980s named Alberta to accompany Albert. *Id.* For decades, Albert and Alberta have appeared at every home game and other University-related events and continue to serve as the University's beloved GATOR Mascot today. *Id.* at 34:25-35:18, Exs. 21-22.



Since the University's adoption of the GATORS mark over 100 years ago, every aspect of the University's identity has been (and continues to be) integrally tied to its GATORS Marks. For example, the University's marching band is named the "Fighting Gators Band," which has been the band's name since as early as the 1940s. *Id.* at 31:14-32:9, Ex. 17. The FLORIDA GATORS football stadium, which is nicknamed "The Swamp," prominently displays the slogans "This Is Gator Country" and "Home of the Florida Gators." *Id.* at 38:2-39:7, Ex. 25. In fact, all of the University's recruiting materials (*Id.* at 39:8-40:14, Ex. 26), alumni magazines (*Id.* at 40:15-41:2, Ex. 27), websites (*Id.* at 36:25-38:1, 41:3-42:1, Exs. 10, 28), stationary and brochures (*Id.* at 42:19-43:6), athletic uniforms (*Id.* at 43:7-44:7, Exs. 30-31), communications, publications, and buildings on campus (*Id.* at 36:12-24) prominently feature the GATORS Marks.

2. The University's Use of its GATORS Marks In Connection With Retail Store Services and Other Goods and Services

Since as early as 1955 (nearly 30 years prior to the Gator Shop's alleged first use date in 1984), the University has used its GATORS Marks in connection with retail store services, mail order sales services, and distributorship services and entertainment services. Opp's NOR 0001 – 0011, Ex. 1. Since the 1960s (over 20 years before the Gator Shop's alleged first use date in 1984), authorized apparel and merchandise bearing the University's GATORS Marks have been sold at the University's campus bookstore. *Id.* at 64:23-66:13, Exs. 47-48.



Since as early as 1982 (2 years prior to the Gator Shop's alleged first use date in 1984), licensed apparel and merchandise featuring the University's GATORS Marks have been sold at the "Gator Gift Shoppe," which is the retail store located within the University's football stadium. *Id.* at 61:19-63:14, Exs. 43-45; Drucker Dep. at 18:17-19:5, Ex. 6.



For decades, the University has operated online retail stores under its GATORS Marks at various domain names, including the Gator Locker Room online store at SHOP.GATORZONE.COM. Gay Dep. at 63:15-64:7, Exs. 46-48.

Since as early as 1982 (2 years prior to the Gator Shop's alleged first use date in 1984), the University has licensed use of its GATORS Marks in connection with a wide variety of apparel and merchandise, including apparel, hats, merchandise, and videos of FLORIDA GATORS games. *Id.* at 25:16-26:7, 44:8-47:5, 57:20-60:18, 63:10-14, Exs. 13, 32-33, 44, 45; Drucker Dep. at 17:4-18:16, Exs. 3-5. The University also has licensed use of its GATORS Marks for retail stores services. Gay Dep. at 66:14-67:9, Ex. 49. Examples of the University's licensed products and services are depicted below:




Gay Dep. at 62:24-63:14, 63:22-64:7, 65:20-67:9, Exs. 45-49; Drucker Dep. at 19:6-22:19, Exs. 7-8; Fincher Dep., Ex. 8.






For decades, licensed products bearing the University's GATORS Marks have been sold in retail stores operated by the University as well as its licensees located in the city of Gainesville, the State of Florida, and nationwide. Gay Dep. at 60:19-61:3, 64:8-22, 67:10-24, Ex. 50. Moreover, since the University first fielded its GATORS football team in 1906, the University has been offering entertainment

services, including athletic competitions and events, under its GATORS Marks. *Id.* at 26:8-28:7, 30:6-31:13, Exs. 14-16; Opp's NOR 0001-0011, Ex. 1.

3. The University Owns Multiple Prior Issued Registrations for its GATORS Marks, Several of Which Are Incontestable

The University is the registered owner of 12 U.S. trademark registrations for its GATORS Marks, including the following:

Mark	Reg. No.	Reg. Date	Goods and Services (Date of First Use)
GATORS	1222098	Dec. 28, 1982	Class 041: Entertainment Services-Namely, Conducting Intercollegiate Athletic Events for Others (Date of First Use: 1955) Class 042: Retail Store Stores, Distributorship Services and Mail Order Sales Services, in the Field of Wearing Apparel and Accessories, Novelty Items and Jewelry (Date of First Use: 1955)
GATORS	2206967	Dec. 01, 1998	Class 025: clothing, namely, shirts, T-shirts, sweat shirts, sweat pants, boxer shorts, sweaters, coats, caps and hats (Date of First Use: 1955)
	2205439	Nov. 24, 1998	Class 025: clothing, namely, shirts, T-shirts, sweat shirts, sweat pants, boxer shorts, sweaters, coats, caps and hats (Date of First Use: 1979)
GATORSDVD	3812440	Jul. 06, 2010	Class 035: On-line retail stores services in the field of DVDs concerning the University of Florida (Date of First Use: Jan. 2006)
FIGHTING GATORS	1225119	Jan. 25, 1983	Class 025: Apparel-Namely, Shirts, Bibs, Socks and Caps (Date of First Use: 1955)
FLORIDA GATORS	2349246	May 16, 2000	Class 025: clothing, namely, shirts, T-shirts, sweat shirts, sweat pants, sweaters, coats, caps and hats (Date of First Use: 1980) Class 041: entertainment services, namely, arranging and conducting athletic events, tournaments and exhibitions (Date of First Use: 1977)

GATOR VISION	3232732	Apr. 24, 2007	<p>Class 025: Clothing, namely, shirts (Date of First Use: Aug. 1998)</p> <p>Class 041: entertainment services, namely providing sporting events over the internet (Date of First Use: Aug. 1998)</p>
	1228944	Mar. 01, 1983	Class 025: Apparel-Namely, Shirts, Sweaters, Belts and Caps (Date of First Use: Jan. 1980)
	2208807	Dec. 08, 1998	Class 025: clothing, namely, shirts, T-shirts, sweat shirts, sweat pants, sweaters, coats, caps and hats (Date of First Use: 1995)
	1970217	Apr. 23, 1996	Class 041: entertainment services, namely conducting intercollegiate athletic events (Date of First Use: Nov. 1994)
	1975079	May 21, 1996	Class 025: wearing apparel, namely tee-shirts, hats and shorts (Date of First Use: Jan. 01, 1995)
	3352139	Dec. 11, 2007	<p>Class 014: lapel pins, watches, precious metal money clips, pendants, earrings, tie tacks, rings, bracelets, bracelet charms, precious metal key chains (Date of First Use: Jan. 01, 1995)</p> <p>Class 016: notebooks, paper tablecloths, paper gift bags, temporary tattoos, gift wrap paper, calendars, memo pads, pencils, pens, greeting cards, address labels, stationery, printed party invitations, photo albums, self-stick notes, namely, adhesive notepads, tissue paper for wrapping presents (Date of First Use: Jan. 01, 1995)</p> <p>Class 021: bowls, ceramic mugs, travel mugs, plastic mugs, pilsner drinking glasses, drinking stems, candy jars, glass storage jars, paper plates, plastic cups, paper cups, bottle openers,</p>

			<p>crystal decanters, drinking glasses (Date of First Use: Jan. 01, 1995)</p> <p>Class 028: paper streamers, namely, party streamers made of paper, basketballs, footballs, golf balls, divot repair tools, volleyballs, baseballs, soccer balls, basketball hoop backboards, stuffed toy animals, checker games, dart games, playing cards, puzzles, snow globes, Christmas tree ornaments (Date of First Use: Jan. 01, 1995)</p>
--	--	--	--

NOR 0001 – 0108, Exs. 1-12. Each of the above registrations for the University’s GATORS Marks was issued well prior to Nov. 23, 2011, the date on which Gator Shop filed its application for the GATOR SHOP Mark. Moreover, many of the above registrations for the University’s GATORS Marks claim dates of first use long before March 1, 1984, the alleged date of first use of the GATOR SHOP Mark. All of these registrations are valid and in full force and effect, and affidavits have been filed and accepted pursuant to Sections 8 and 15 of the Lanham Act for Registration Nos. 1,222,098; 2,206,967; 2,205,439; 1,225,119; 2,349,246; 3,232,732; 1,228,944; 2,208,807; 1,970,217; 1,975,079, rendering such registrations incontestable.

4. The GATORS Marks are Widely and Exclusively Associated with the University

For over a century, the University has extensively advertised and promoted the GATORS Marks. The University spends over \$5 million each year on advertising. Gay Dep. at 23:13-17. The athletics department alone, which is just one department of the University, spends nearly \$1 million each year on advertising. *Id.* at 23:18-24. All of this advertising, which includes a variety of print, television, and Internet advertising, make widespread use of the University’s GATORS Marks. *Id.* at 23:25-24:5, 61:4-9.

a. The University’s Print Advertising

Throughout its long history, the University has extensively used print advertising to promote its GATORS Marks. As discussed above, the University’s student newspaper has featured the University’s GATORS Marks since as early as the 1910s. Gay Dep. at 29:11-31:13, Ex. 16. The University’s printed athletic programs display the University’s GATORS Marks on almost every page and are printed annually

and distributed at every game since as early as the 1920s. *Id.* at 26:8-24, Ex. 14. The University's printed media guides for all of its athletic teams display the University's GATORS Marks on almost every page and have been printed annually since as early as the 1940s. *Id.* at 26:25-28:7, Ex. 15. The University's recruiting materials and alumni magazine, which prominently use the University's GATORS Marks, reach hundreds of thousands of potential students nationwide and alumni of the University each year. *See id.* at 11:10-12:20, 39:8-42:1, Exs. 26-27. The University distributes hundreds of thousands of brochures, flyers, pamphlets, athletic schedules, university communications, student life communications, and stationary bearing the University's GATORS Marks to consumers each year. *See id.* at 11:10-12:20, 25:2-15, 36:12-24, 41:3-42:1, Ex. 2.



The University also routinely issues press releases that feature the University's GATORS Marks. *Id.* at 42:2-18, Ex. 29. Since as early as the 1960s, the University has advertised its GATORS Marks in annual product catalogs distributed by the University for the Gator Gift Shoppe and its on-campus bookstore. *Id.* at 62:24-63:14, 64:23-66:13, Exs. 14, 48. Moreover, the University has advertised its retail store services in the University's *Today* alumni magazine and other publications for decades. *See id.* at 61:4-9, 62:14-23, 64:23-65:11, Exs. 44, 47.

b. The University's Television Advertising

For decades, the University's television advertising has included recruiting videos, commercials featuring the University's athletic teams and players, and commercials featuring the University's GATOR Mascot. *Id.* at 24:14-25:1, 35:19-36:2, Exs. 11, 23. All of these commercials and videos make widespread use of the University's GATORS Marks. *See id.* For decades, the University's television

commercials and videos have aired on many network and cable television stations, including ESPN. *Id.* at 35:19-36:2, Ex. 23. In fact, the University's GATOR Mascot "Albert" was featured alongside Steve Irwin in one of the most memorable TV commercials involving college mascots ever aired on ESPN. *See id.*



c. The University's Internet Advertising

For many years, the University has had an extensive Internet presence, including the University's athletics website at GATORZONE.COM and the University's educational website at UF.EDU. *Id.* at 24:6-13, 41:3-42:1, Exs. 10, 28. All of the University's websites make extensive use of the University's GATORS Marks. The University's GATORZONE.COM homepage alone is replete with the University's GATORS Marks, including the GATOR Head Logo, FLORIDA GATORS, GATOR Locker Room, GATOR Tickets, GATOR Albert logo, Coaching the GATORS, GATORZoneNews, Follow the GATORS, and Carry Your GATOR Pride. *Id.* at 24:6-13, 36:25-38:1, Ex. 10.



The University's online retail stores at SHOP.GATORZONE.COM and UFL.BKSTR.COM, which sell licensed apparel and merchandise bearing the University's GATORS Marks, also extensively promote the University's GATORS Marks. *Id.* at 63:15-64:7, 64:23-65:25, Exs. 46, 48; Fincher Dep., Ex. 8.

5. The University Has Sold Well Over \$ 1 Billion Dollars Worth of Goods and Services Under the GATORS Marks

As the University's incontestable registration for its GATORS mark (Reg. No. 1222098) illustrates, the University has been offering retail store services under the GATORS Marks since as early as 1955. Opp's NOR 0001-0011, Ex. 1. These retail store services have included distributorship services and mail order sales services for University of Florida GATORS-branded goods and services. *Id.* Since as early as the 1960s, the University has operated its on-campus retail store which sells a wide variety of University of Florida GATORS-branded apparel and merchandise. *Id.* at 64:23-65:25, Ex. 47. Since as early as the 1980s, the University has operated a retail store named the "Gator Gift Shoppe" within its football stadium to sell University of Florida GATORS-branded apparel and merchandise. *Id.* at 62:14-63:14, Ex. 44; Drucker Dep. at 18:17-19:5, Ex. 6. In fact, the University's Licensing Manager, Debbie Gay, who worked at the Gator Gift Shoppe retail store operated by the University, was featured in a 1982 article from the *Gainesville Sun* about the Gator Gift Shoppe:

- Q: I'm showing you what has been marked as Exhibit 43 to your testimony deposition. Can you tell us what is contained in Exhibit 43?
- A: This is a picture from 1982 of the Gator Gift Shop selling apparel and other merchandise bearing the Gator marks from 1982.
- Q: Do you recognize the person in the picture?
- A: Yes, that would be me.
- Q: Is the picture reflected in Exhibit 43 a good representative example of the types of licensed merchandise that the university was selling back in the early 1980s?
- A: Yes, it does.
- Q: And you can see from some of those, although the picture is somewhat blurry, the Gator word mark on the helmet and also on the shirt at the very front of the photograph?
- A: Yes.

Gay Dep. at 61:19 – 62:13, Ex. 43.

For decades, the University has continued to sell University of Florida GATORS-branded apparel and merchandise in its retail stores and through licensees of the University. *Id.* at 64:8-22, 67:10-24, Ex. 50; Drucker Dep. at 23:22-24:2. Within the last 10 years alone, the University has sold nearly \$1 billion worth of licensed apparel and merchandise. Drucker Dep. at 24:3-13, Ex. 9. Nearly all of such licensed products bear the University's GATORS Marks. Gay Dep. at 56:13-57:19, 63:15-64:7, 64:23-65:25, Exs.

41, 46, 48; Drucker Dep. at 19:6-22:19, Exs. 7-8. The University has experienced significant sales of University of Florida GATORS-related apparel and merchandise given the popularity of the GATORS and strong affiliation that students, fans, and alumni have for the University. *See* Gay Dep. at 47:6-48:13, Ex. 34.

6. The University's GATORS Marks Have Received Extensive Media Attention

In addition to its academic strength, the University has displayed tremendous aptitude in athletic competitions. As a member of the National Collegiate Athletic Association ("NCAA") and Southeastern Conference ("SEC"), the University has 21 varsity teams for both men's and women's sports. *Id.* at 12:21-13:10. All of the University's athletic teams are known as the "GATORS" (referred to herein as "Florida GATORS" or "University of Florida GATORS"). The University of Florida GATORS have been recognized as the best overall in the SEC for over two decades and have consistently been recognized as one of the best in the nation. *Id.* at 13:11-14:4, 16:2-9, Ex. 5.

Since the University of Florida first fielded its GATORS football team in 1906, the Florida GATORS athletic teams have been extraordinarily successful and nationally recognized. *Id.* at 14:5-15:3, Exs. 3-4. Their athletic successes include the following:

- The Florida GATORS football team has won three National Championships (1996, 2006, 2008), eight SEC titles, and participated in a total of 37 bowl games. *Id.* at 15:4-17, Ex. 4.
- The Florida GATORS men's basketball team won the Division I Men's Basketball National Championship two years in a row in 2006 and 2007 and six SEC titles, including for three consecutive years, 2005-2007. *Id.* at 21:20-22:6, Ex. 4.
- The Florida GATORS gymnastics team has won two National Championships and nine SEC titles. *Id.* at 22:7-10, Ex. 4.
- The Florida GATORS tennis team has won six National Championships and 36 SEC titles. *Id.* at 22:11-16, Ex. 4.

- The Florida GATORS volleyball team has won 20 SEC titles. *Id.* at 22:17-20, Ex. 4.
- The Florida GATORS baseball team has won 12 SEC titles. *Id.* at 22:21-24, Ex. 4.

As a result of the University's athletic successes, the University's GATORS athletic teams have been extensively featured on television broadcasts and in print and online media nationwide for decades. For instance, the University's GATORS football team games have been nationally televised since as early as the 1960s exposing millions of viewers to the University and its GATORS Marks. *Id.* at 16:10-21:19, 23:4-12, Exs. 6-9. In every televised game, the University's GATORS Marks appear on each player's athletic uniform (*Id.* at 43:7-44:7, Exs. 30-31), on the apparel worn by the University's fans, on signs and merchandise held by the University's fans (*Id.* at 47:6-48:13, Ex. 34), and in the end zones and on the walls of "The Swamp" (*Id.* at 38:2-39:7, Ex. 25).



As a result of the success of the FLORIDA GATORS athletic teams and the popularity of its current and former players (including former quarterback Tim Tebow), the University and its well-known GATORS Marks have attracted an unprecedented level of widespread and unsolicited media attention from news media since as early as the 1920s. *Id.* at 14:5-15, 72:17-73:4, Ex. 3. The University and its GATORS Marks have been featured in numerous national general-interest publications, including *The*

New York Times, *The Washington Post*, and *USA Today*, as well as America's preeminent sports magazine, *Sports Illustrated*. *Id.* at 48:14-50:3, 50:16-52:15, Exs. 35, 37. In fact, the University and its GATORS Marks are so popular that they have been featured on over 27 *Sports Illustrated* covers since as early as 1982 and in countless other news and magazine articles for many decades. *Id.* at 50:16-53:4, Ex. 37. The University's GATOR Mascot also has received substantial unsolicited media attention, including being ranked the No. 1 college mascot in the *Sports Illustrated* Mascot Power Rankings in 2007. *Id.* at 36:3-11, Ex. 24. The University and its GATORS athletic teams also have been the subject of numerous books and articles written by third parties about the University. *Id.* at 50:4-15, Ex. 36. This media attention focuses not only on the University, its athletic successes, and current and former players, but also prominently highlights the GATORS Marks, which are used by the news media to refer exclusively to the University and its GATORS athletic teams.

7. The Public Associates the University's GATORS Marks with the University

Through the University's longstanding and extensive use of its GATORS Marks, the public has come to instantly recognize the University's GATORS Marks as a symbol of the University. As discussed previously, the news media's frequent use of the GATORS Marks to refer to the University and its athletic teams since as early as the 1920s confirms the public's association of the marks with the University. *Id.* at 48:14-50:3, Ex. 35. Since as early as the 1950s, the University's fans use the GATORS mark and various depictions of the GATOR Mascot to show support for the University during homecoming festivities and activities. *Id.* at 32:10-33:3, Ex. 18. Moreover, the University's fans wear apparel bearing the University's GATORS Marks (as well as hold up signs and paint their bodies with the word GATORS) to show support for the University of Florida GATORS athletic teams. *Id.* at 47:6-48:13, Ex. 34.

B. The University's Well-Known Orange-and-Blue Color Mark

The University's Orange-and-Blue Color Mark consists of the colors orange and blue as applied to University of Florida GATORS-related goods and services.² More than 100 years ago, the University adopted the unique and distinctive Orange-and-Blue Color Mark. *Id.* at 52:16-53:4; Drucker Dep. at 22:20-22. Since the University first adopted the Orange-and-Blue Color Mark, the University has used it in connection with virtually every facet of the University, from academics to athletics.

The University's Alma Mater and other traditions (which are performed at nearly every football game and other athletic events) intimately reference the University's Orange-and-Blue Color Mark, as shown below. Gay Dep. at 53:18-54:15, Ex. 39.

The Orange and Blue
On, brave old Flor-i-da, just keep on marching on your way!...
On, brave old Flor-i-da, and we will cheer you on your play! Raht! Raht! Raht!...
And as you march a-long, we'll sing our victory song anew...
With all your might Go on and Fight Gators Fight for Dixie's rightly proud of you...

The University's athletic team uniforms since as early as the 1910s until present have incorporated the University's Orange-and-Blue Color Mark. *Id.* at 53:5-17, Ex. 38. In fact, every uniform since as early as the 1910s has made use of the University's Orange-and-Blue Color Mark. *Id.* Examples of the University's earliest athletic uniforms featuring the University's Orange-and-Blue Color Mark are depicted below.



Like the University's GATORS Marks, the University widely uses its Orange-and-Blue Color Mark in connection with every aspect of the University, including the University's recruiting materials,

² The University does not claim that all uses of the Orange-and-Blue Color Mark infringe its rights. Instead, only when the Orange-and-Blue Color Mark is used in connection with other trademarks or indicia of the University does such an unauthorized use create consumer confusion and thus infringe on the University's rights in the Orange-and-Blue Color Mark.

The Swamp, alumni magazines, websites, stationary, brochures, communications, publications, media guides, football programs, licensed products, and buildings on campus, to name a few. *Id.* at 55:10-56:7, Ex. 25. Moreover, most of the University's trademarks, including its GATORS Marks, incorporate the Orange-and-Blue Color Mark. *Id.* at 55:5-9.

Since at least as early as 1980, the University has licensed its Orange-and-Blue Color Mark in connection with a wide variety of apparel and merchandise, including apparel, hats, mugs, bowls, key chains, ornaments, watches, license plate holders, playing cards, and beach towels. Drucker Dep. at 18:17-23:17, Exs. 6-8; Gay Dep. at 56:3-12. Similarly, the University regularly publishes visual identity guidelines for use of its Orange-and-Blue Color Mark to ensure consistent presentation of the University's brand. Gay Dep. at 54:16-55:4, Ex. 40. The University's licensing agreements covering its Orange-and-Blue Color Mark even specify the Pantone and thread colors for depicting the exact colors. *Id.* at 56:13-57:19, Ex. 41.

Through this longstanding use, consumers immediately recognize the University's Orange-and-Blue Color Mark as referring to the University. Even the Gator Shop admits that the University's colors are orange and blue. Opp's NOR 0326-0487, Exs. 14-16 (Request No. 43); Fincher Dep. at 9:8-11. In the past ten years alone, licensed retail sales of University of Florida GATORS-related merchandise, nearly all of which bear the Orange-and-Blue Color Mark, totaled nearly \$1 billion dollars. Drucker Dep. at 24:3-13, Ex. 9. As a result of decades of use, promotion, and sales, the University has owned extensive common-law rights in the Orange-and-Blue Color Mark for many years, and well prior to Gator Shop's first use.

C. Applicant and Its GATOR SHOP Mark

As the name suggests, the Gator Shop is a retail store located right across from the University that sells University of Florida GATORS-related products. Gay Dep. at 69:17-73:4, Ex. 52; Fincher Dep. at 42:18-43:20; Opp's NOR 0326-0487, Exs. 14-16 (Request No. 57 and Supplemental Response). While the brick and mortar store location of the Gator Shop closed down in March 2012, the Gator Shop continues to be operated as an online retail store and through various pop-up retail locations in and around

the University for the University's athletic games and other events. Fincher Dep. at 11:1-12:15. For example, during the University of Florida GATORS football season, the Gator Shop sells University of Florida GATORS-related products from the lawn of a church located directly across the street from the University. *See id.*

The Gator Shop is owned by Joe Fincher, who lives in Gainesville, Florida, where the University is located. Mr. Fincher has been aware of the University since as early as 1972, when he worked as an independent manufacturers' representative selling collegiate products to the University of Florida's campus bookstore. Fincher Dep. at 4:8-12, 6:20-7:15. Mr. Fincher admits that he has long known that the University's mascot is the GATORS, that the University owns the GATORS Marks, that the University's colors are orange and blue, and that the University owns the GATORS Marks for a wide variety of goods and services related to the University. Fincher Dep. at 23:20-24:3, 25:4-10; Opp's NOR 0326-0487, Exs. 14-16 (Request Nos. 42 and 46). In fact, he admitted that "it's been a while" since he first became aware of those facts. *See id.*

Nevertheless, in 1984, Joe Fincher began operating the Gator Shop and selling University of Florida GATORS-related products in this store. Fincher Dep. at 9:21-10:7, 42:18-43:20; Gay Dep. at 69:17-73:4, Ex. 52. While Mr. Fincher purchased the store from a prior owner, he chose the GATOR SHOP name because it was a "good location, good name" and located "right on University" (*i.e.*, the road that runs directly in front of the University of Florida). Fincher Dep. at 22:15-24:3. At various times, the Gator Shop employed students enrolled at the University of Florida. *Id.* at 20:1-9. Joe Fincher's three daughters, who helped run the Gator Shop at various points in time, all graduated from the University of Florida. *Id.* at 19:8-20:19. Two of his three daughters married former members of the GATORS football team who now regularly promote at the Gator Shop during football season by signing autographs and talking to fans. *Id.* at 68:6-70:7.

Since the Gator Shop's first use of the GATOR SHOP Mark in 1984, almost all of the products sold by the Gator Shop have been University of Florida GATORS-related products. Fincher Dep. at 38:11-15, 39:12-41:9, 52:22-54:13. Some of the products sold by the Gator Shop are officially licensed

by the University and are purchased at wholesale by the Gator Shop from licensed manufacturers (who pay royalties to the University). *See* Opp’s NOR 0326-0487, Exs. 14-16 (Request No. 55); Fincher Dep. at 25:4-26:14. Some of the products that the Gator Shop sells are not licensed by the University; however, the Gator Shop sells them because they incorporate the University’s trademarks and appeal to fans of the University. *See* Opp’s NOR 0326-0487, Exs. 14-16 (Request No. 56); Fincher Dep. at 31:17-22. Examples of University of Florida GATORS-related products sold at the Gator Shop include the following:



See Gay Dep. at 69:17-77:19, Ex. 52; Fincher Dep., Exs. 6, 15; Opp’s NOR 0338-0469 (Exhibits A-M to Request No. 58). The Gator Shop admits that it was aware of the University’s trademark licensing program and that the University licenses its GATORS Marks for use on University of Florida GATORS-related products. *Id.* at 25:4-26:14. However, the Gator Shop never obtained a license from the University to use its GATORS Marks. *Id.* at 29:15-22; Drucker Dep. at 26:5-12; Gay Dep. at 69:9-16.

As evidenced by its selection of the GATOR SHOP Mark for its “good location, good name” and sale of University of Florida GATORS-related products under this mark, the Gator Shop specifically targets students, fans, and alumni of the University. Fincher Dep. at 22:15-23:19, 31:17-22, 38:11-15; Opp’s NOR 0326-0487, Exs. 14-16 (Request Nos. 85-89).

The Gator Shop's advertising and promotion of the GATOR SHOP Mark confirms its intent to trade on the goodwill of the University and its trademarks. Examples include:

- Advertising the GATORSHOP.COM website in web searches with the captions “Gator Shop - University of Florida Gators apparel” and “Buy University of Florida GATORS apparel, Gator football merchandise, gear, sportswear, and more”, as shown below. Fincher Dep. at 50:6-52:8, Ex. 7.

Gator Shop - University of Florida Gators apparel, Gator ...
www.gatorshop.com/
Buy University of Florida Gators apparel, Gator football merchandise, gear, sports wear, and more. Lowest prices on clothing – buy a Gator shirt, bag, jersey, hat, ...

- Incorporating the University's Orange-and-Blue Color Mark in the GATOR SHOP Logo and other uses of the GATOR SHOP Mark on the GATORSHOP.COM website, as shown below. *Id.* at 42:18-43:24, Ex. 5; Gay Dep. at 69:17-77:19, Ex. 52; Fincher Dep., Ex. 6.



Gator Shop

- Use of the University's GATORS Marks, Orange-and-Blue Color Mark, and other indicia of the University on the GATORSHOP.COM website, including the following:
 - In the Header: *Gator Shop -University of Florida Gators apparel, Gator merchandise, Football Sports Wear, t-shirts, hats, & more.* Gay Dep. at 69:17-70:18, Ex. 52;
 - As Product Categories: *Gator T-shirts, Gator Hats, 15 Tim Tebow merchandise.* *Id.* at 72:17-73:18, Ex. 52;
 - As GATORS football schedules. GATOR SHOP App. File (Specimen); Fincher Dep. at 42:18-43:24, Ex. 5; Gay Dep., Ex. 52; and
 - In the orange and blue color scheme of the website. *Id.* at 71:10-13, Ex. 52.



- Use of the University's GATOR Mascot (specifically, the Albert Design depicted 6 times across the top and 6 times along the side) in advertising for the Gator Shop's "Spirit Club" Membership. Fincher Dep. at 74:14-75:6, Ex. 12.

This is a membership form for the Gator Shop Spirit Club. At the top, it says 'FROM: THE GATOR SHOP' and 'TO: Our Loyal Gator Fans & Customers'. Below this, a paragraph explains that the Spirit Club is a great way to show support for orange & blue spirit and save money, and that for the best in UF apparel and merchandise, it's THE GATOR SHOP. The form lists the benefits of membership, including a 10% discount card, a t-shirt and license plate, a baseball cap, a t-shirt for bowl game, and entry in a drawing for a leather jacket. It also mentions a private members only sale. The annual membership fee is listed as \$39.95. On the right side, there is a section for joining the club, which includes a form to complete and mail in or call 904/376-5191. The form includes fields for name, address, city, state, zip, phone, and email. It also has a section for payment method (check or charge) and a place for the authorized signature. At the bottom right, the Gator Shop's address is listed: 1700 West University Ave., Gainesville, FL 32604. A small 'PLAINTIFFS EXHIBIT 12' stamp is visible in the bottom left corner.

- Use of the University of Florida's abbreviated name "UofF" as the telephone number for the Gator Shop. *Id.* at 77:21-78:13, Ex. 14.



- Use of numerous indicia of the University in product catalogs, including pictures of the University's homecoming parade, Fighting Gators Band, The Swamp, GATORS football players, and various references to coaches, gamedays, football schedules, and fans of the University of Florida GATORS, as shown below. Fincher Dep. at 44:21-78:13, 78:19-82:15, Exs. 14-15.



- Use of the University's "Go Gators" cheer for the University of Florida GATORS athletic teams and depicting "Go Gators" in contrasting Orange-and-Blue font, as shown below. Gay Dep. at 75:23-76:9, Ex. 52.

Go Gators

As the above advertising clearly illustrates (and the Gator Shop concedes), the Gator Shop's target customers are students, fans, and alumni of the University. Opp's NOR 0326-0487, Exs. 14-16 (Request No. 85-88); Fincher Dep. at 52:22-54:13. The Gator Shop advertises its GATOR SHOP Mark through a variety of print, television, and Internet advertising, including in identical publications as the

University, such as the University's student newspaper and alumni magazine. Fincher Dep. at 41:16-42:9, 43:21-24, 66:4-68:5, 70:24-74:8, Exs. 4-5, 11. The Gator Shop also prints a product catalog under its GATOR SHOP Mark which is distributed to over 50,000 customers each year. *Id.* at 32:4-12, 77:21-78:13, Ex. 14. The Gator Shop frequently uses direct mail solicitations and email blasts targeted at students, fans, and alumni of the University to advertise the GATOR SHOP Mark. *Id.* at 46:17-48:25, 54:15-58:17, 58:23-59:21, Exs. 6, 9-10, 12. In fact, the first email blast list was compiled from a list of purchasers of University of Florida GATORS license plates in the State of Florida. *Id.* at 82:17-83:6. Moreover, the Gator Shop uses the GATOR SHOP Mark on promotional items like magnets with GATORS football schedules and distributes these promotional items to students, fans, and alumni of the University. *Id.* at 76:10-24, Ex. 13.

Despite the University's longstanding rights in and ownership of its GATORS Marks (which the Gator Shop concedes), the Gator Shop subsequently sought a U.S. trademark registration for the GATOR SHOP Mark, filing its use-based Application Serial No. 85/480,582 on November 23, 2011 for services that are identical to those long offered by the University under its GATORS Marks (the "Application"). Specifically, "On-line retail store services featuring a wide variety of consumer goods of others; Retail shops featuring clothing, sports team clothing, and a wide range of consumer goods of others" in International Class 35, claiming a date of first use of March 1, 1984.

V. ARGUMENT

A. The University Has Standing

By virtue of its uncontested ownership of valid and subsisting registrations for the GATORS Marks,³ the University satisfies the threshold inquiry as to standing. *Lacoste Alligator S.A. v. Maxoly, Inc.*, 91 U.S.P.Q.2d 1594, 1599 (T.T.A.B. 2009); *Starbucks U.S. Brands LLC v. Ruben*, 78 U.S.P.Q.2d 1741, 1750 (T.T.A.B. 2006).

B. The University Has Priority

In light of University's 12 pleaded registrations for its GATORS Marks, the University's

³ Opp's NOR 0001-0108, Exs. 1-12.

common law use of its GATORS Marks for nearly 80 years before the Applicant's alleged first use date in 1984, as well as the University's common law use of its GATORS Marks for over 100 years before Applicant's filing date in 2011, priority is not an issue in this proceeding.

1. The University Has Priority Based On Its 12 Pleaded Registrations Covering Retail Store Services, Entertainment Services, and Apparel

As previously discussed, the University has made 12 pleaded registrations for its GATORS Marks properly of record, including the following 6 incontestable registrations for which the first use date in the registration predates the Gator Shop's alleged first use date of 1984:

- Incontestable Reg. No. 1222098 for the mark GATORS for entertainment services in Class 41 and retail store services in Class 42, claiming a date of first use of 1955 for both classes (Opp's NOR 0001 - 0011, Ex. 1);
- Incontestable Reg. Nos. 2206967 for the mark GATORS for clothing and hats in Class 25, claiming a date of first use of 1955 (Opp's NOR 0012 - 0023, Ex. 2);
- Incontestable Reg. No. 1225119 for the mark FIGHTING GATORS for clothing and hats in Class 25, claiming a date of first use of 1955 (Opp's NOR 0038 - 0048, Ex. 5);
- Incontestable Reg. No. 2205439 for the GATORS (Stylized) mark for clothing and hats in Class 25, claiming a date of first use of 1979 (Opp's NOR 0024 - 0033, Ex. 3);
- Incontestable Reg. No. 2349246 for the mark FLORIDA GATORS for clothing and hats in Class 25 and entertainment services in Class 41, claiming a date of first use of 1980 for Class 25 and 1977 for Class 41 (Opp's NOR 0049 - 0058, Ex. 6); and
- Incontestable Reg. No. 1228944 for the Standing Albert Design for clothing and hats in Class 25, claiming a date of first use of 1980 (Opp's NOR 0068 - 0077, Ex. 8).

It is well-established TTAB precedent that "[t]he question of priority does not arise against a *registered* mark in an opposition proceeding. That is, prior use need not be shown by an opposer relying on a registration of its pleaded mark for its pleaded goods or services unless the applicant counterclaims for cancellation." *Ultratan Suntanning Ctrs. Inc. v. Ultra Tan Int'l AB*, 49 U.S.P.Q.2d 1313, 1315 (T.T.A.B. 1998) (emphasis added). In view of the University's ownership of 12 pleaded registrations for its GATORS Marks, which are all valid and subsisting registrations, the University's priority with respect to retail store services, mail order sales services, distributorship services, entertainment services, and apparel is not in issue. *See Brown Shoe Co. v. Robbins*, 90 U.S.P.Q.2d 1752 (T.T.A.B. 2009) (finding

priority not in issue as opposer made its pleaded registrations of record).

2. The University Has Priority Based on Its Common Law Use Before Applicant's Alleged First Use Date of 1984

The University has priority based on its common law use of the GATORS Marks for a wide variety of goods and services since as early as 1906 (nearly 80 years prior to the Applicant's alleged first use date of 1984). As discussed previously, numerous media articles about the University's history and testimony from the University's Licensing Manager, Debbie Gay, confirm the University's first use of the GATORS mark in 1906 to refer to the University and its athletic teams. Gay Dep. at 15:24-16:1, 28:8-16, 33:4-33:15, Ex. 19. Since the 1910s, the University's student newspaper has used the GATORS Marks to refer to the University, its athletic teams, students, fans, and alumni. *Id.* at 29:11-31:13, Ex. 16. Since as early as the 1920s, the University's football programs have prominently featured the GATORS Marks. *Id.* at 26:8-24, Ex. 14. Unsolicited news media articles, including *The New York Times*, dating back to as early as the 1920s have used the GATORS Marks to refer to the University and its athletic teams. *Id.* at 48:14-50:3, Ex. 35. Since as early as the 1940s, the University's media guides for its athletic teams have used the GATORS Marks. *Id.* at 26:25-28:7, Ex. 15. For decades, the University has used its GATOR Marks in connection with a wide variety of goods and services, including retail stores, entertainment services, clothing, hats, merchandise, and advertising. Opp's NOR 0001-0108, Exs. 1-12. Since as early as the 1960s, the University has operated its on-campus retail store offering University of Florida GATORS-branded apparel and merchandise. Gay Dep. at 64:23-66:13, Exs. 47-48. Since as early as 1980 (4 years prior to the Gator Shop's alleged first use date of 1984), the University has licensed use of its GATORS Marks, including for retail stores, apparel, and a broad spectrum of merchandise including mugs, bowls, key chains, ornaments, watches, license plate holders, playing cards, and beach towels. *Id.* at 25:16-26:7, 44:8-47:5, 57:20-60:18, 63:10-14, Exs. 13, 32-33, 42, 45; Drucker Dep. at 17:4-18:16, Exs. 3-5. Since as early as 1982 (2 years prior to the Gator Shop's alleged first use date of 1984), the University has operated its Gator Gift Shoppe retail store located within the University's football stadium selling University of Florida GATORS-branded apparel and merchandise. Gay Dep. at 61:19-63:14, Exs.

43-45; Drucker Dep. at 18:17-19:5, Ex. 6. In light of the University's first use of its GATORS Marks since 1906 (nearly 80 years prior to the Gator Shop's alleged first use date of 1984), there is no issue as to priority for retail stores services, entertainment services, apparel, and merchandise.

3. The University Has Priority Based on Its Common Law Use Before Applicant's Filing Date in 2011

As discussed above, the University adopted its GATORS Marks in 1906 and has established strong common law rights for a wide variety of goods and services well over 100 years prior to the Gator Shop's filing date in 2011. Thus, priority is not an issue.

Accordingly, the University's claims of likelihood of confusion and false suggestion of an affiliation are the only issues remaining for adjudication.

C. Likelihood of Confusion Exists Between the University's GATORS Marks and the GATOR SHOP Mark

Applicant's GATOR SHOP Mark is confusingly similar to the University's GATOR SHOP Marks. The issue of likelihood of confusion is governed by the factors described by the court in *In re E.I. du Pont de Numours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973):

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods and services as described in any application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e. whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

Id. at 1361. To prevail, the University need not prove that all, or even most, of these factors favor a likelihood of confusion. *See id.* at 1362. The Board need only consider those factors for which the parties present evidence and “may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001). Nonetheless, all factors for which there is record evidence favor a finding that the GATOR SHOP Mark is likely to cause confusion with the University’s GATORS Marks. The overwhelming weight of the evidence shows:

- (1) the University’s GATORS Marks are strong and distinctive;
- (2) the parties’ services are identical;
- (3) the University’s GATORS Marks and Applicant’s GATOR SHOP Mark are substantially similar in appearance, connotation, and commercial impression;
- (4) the parties’ target consumers and trade channels overlap;
- (5) there has been actual confusion of Applicant’s GATOR SHOP Mark with the University’s GATOR SHOP Mark; and
- (6) Applicant adopted the GATOR SHOP Mark with knowledge of the University’s rights in its GATORS Marks and with the intent to trade off the goodwill associated with the University’s GATORS Marks.

1. The University’s GATORS Marks Are Strong and Entitled to Broad Protection

Confusion is likely because the University’s GATORS Marks are strong, and therefore entitled to a broad scope of protection. A mark that has acquired distinctiveness through longstanding use, high volume of sales and advertising expenditures associated with the mark, and extensive media coverage is a strong mark. *See E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992) (finding that marks that are not inherently distinctive are “treated as strong marks” upon a showing of acquired distinctiveness); *see also Grand Canyon W. Ranch, LLC v. Hualapai Tribe*, 88 U.S.P.Q.2d 1501, 1507 (T.T.A.B. 2008) (considering the length of use, extent of use in advertising and promotion, the increasing volume of sales, and the level of awareness of the mark in determining whether a mark has acquired distinctiveness); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1041 (2d Cir. 1992) (“Among the factors that we have found relevant to this inquiry in the past are advertising expenditures, consumer studies, sales success, unsolicited media coverage, attempts to plagiarize and length and exclusivity of use.”).

The University's longstanding and widespread use of its GATORS Marks confirms the strength of the GATORS Marks. As discussed above in Section IV.A, the University first adopted its GATORS mark in 1906 and has continued to use its GATORS Marks in connection with a wide variety of educational and entertainment goods and services for over a century. Even the Gator Shop admits that the University owns rights in its GATORS Marks and that its rights to the GATORS Marks are extremely broad:

- Q: You know that the University of Florida mascot is the GATORS?
A: Yes.
Q: Do you also know that the University of Florida owns the GATORS trademark?
A: I think I came across that somewhere along the line.
Q: Do you recall how long ago you learned that?
A: No. No, it's been a while.
....
Q: Do you know through your work as an independent rep or as owner of the Gator Shop that Florida owns the trademark GATORS for clothing?
A: I know that they own the GATORS trademark for a lot of things. And I don't know that it's specifically clothing, but I do know that it's for a lot of things.

Fincher Dep. at 23:20-24:3, 25:4-10.

For decades, the University has licensed use of its GATORS Marks in connection with apparel, merchandise, and even retail stores. Gay Dep. at 25:16-26:7, 44:8-47:5, 57:20-60:18; 63:10-14, Exs. 13, 32-33, 42, 45; Drucker Dep. at 17:4-18:16, 66:14-67:9, Exs. 3-5, 49. These licensed products bearing the GATORS Marks are sold by the University's licensees as well as the University's own retail stores. Gay Dep. at 61:19-64:7, 64:23-65:25, 67:10-24, Exs. 43-46, 48, 50. As a result of the University's longstanding and continuous use of its GATORS Marks, and the extraordinary success of the University's GATORS athletic teams as discussed above in Section IV.A.6, the GATORS Marks have been and continue to be an instantly recognizable symbol of the University.

The University's extensive advertising and promotional efforts featuring its GATORS Marks, which total more than \$5 million annually, reinforces the strength of these marks. Gay Dep. at 23:13-17. For over 100 years, the GATORS Marks have been advertised by the University through a variety of print and television advertising. *Id.* at 23:25-24:5, 61:4-9. The University's advertising and promotional materials include media guides, football programs, student newspapers, nationally-aired television

commercials, recruiting materials, alumni magazines, and a variety of brochures, pamphlets, football schedules, and flyers – all of which prominently display the GATORS Marks. *See* Section IV.1-4.

Sales of products bearing the University’s GATORS Marks have been significant, indicating the distinctiveness of the University’s GATORS Marks. *See Univ. of Ga. Athletic Ass’n v. Laite*, 756 F.2d 1535, 1545 (11th Cir. 1985) (finding extensive use of UGA’s mark by licensees contributed to strength of the mark); *Am. Scientific Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 793 (9th Cir. 1982) (finding acquired distinctiveness after only 149 purchase orders under the claimed mark); *Bd. of Supervisors of La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 658 (E.D. La. 2006) (“The universities market scores of items bearing their color schemes, logos, and designs, and sales of these items exceed tens of millions of dollars.”). For over 100 years, the University has been selling University of Florida GATORS-branded apparel and other products. Since as early as 1955 (nearly 30 years prior to the Gator Shop’s alleged first use date of 1984), the University has been operating retail stores under its GATORS Marks selling University of Florida GATORS-branded apparel and merchandise in its retail stores. As such, sales of University of Florida GATORS-branded apparel and merchandise have well exceeded many billions of dollars. In the past ten years alone, licensed retail sales of University of Florida GATORS-related apparel and other products, nearly all of which incorporate the GATORS Marks, have totaled almost \$1 billion dollars. Drucker Dep. at 24:3-13, Ex. 9. *See* Section IV.5.

As a result of the public’s association of the GATORS Marks with the University, fans of the University regularly wear apparel featuring the GATORS Marks to show support for the University and the GATORS athletic teams. *Id.* at 47:6-48:13, Ex. 34. Since as early as the 1920s, the news media has used the University’s GATORS Marks to refer to the University and the GATORS athletic teams. *Id.* at 14:5-15, 16:10-21:19, 23:4-12, 48:14-50:3, 50:16-52:15, 72:17-73:4, Exs. 3, 6-9, 35, 37. The extensive media coverage, including nationwide and regional media coverage, and unsolicited media references using the GATORS Marks to refer to the University and its athletic teams, are virtually limitless. *Id.* This strong consumer association is further illustrated by numerous books about the University written by third parties using the GATORS Marks to refer to the University. *Id.* at 50:4-15, Ex. 36.

In addition, the University's Orange-and-Blue Color Mark has been synonymous with the University since the University first adopted the mark over 100 years ago. Gay Dep. at 52:16-53:4; Drucker Dep. at 22:20-22. Even the Gator Shop admits the University's colors are orange and blue. Opp's NOR 0326-0487, Exs. 14-16 (Request Nos. 43 and 46); Fincher Dep. at 9:8-11. Like its GATORS Marks, the University's Orange-and-Blue Color Mark has been used in every facet associated with the University from the University's Alma Mater and other traditions to the colors utilized in "The Swamp." Gay Dep. at 53:5-54:15, Exs. 38-39. The University's website, communications, media guides, football programs, advertising materials, recruiting materials, as well as many other types of materials offered by the University all incorporate the University's Orange-and-Blue Color Mark. *Id.* at 55:5-56:7. For decades, the University has licensed use of its Orange-and-Blue Color Mark for a wide variety of goods and services associated with the University. Drucker Dep. at 18:17-23:17, Exs. 6-8; Gay Dep. at 56:3-12. In light of the fact that nearly all licensed products of the University (for which sales have totaled almost \$1 billion within the last ten years alone) incorporate the Orange-and-Blue Color Mark, the University's Orange-and-Blue Mark is a well-known mark of the University.

As a result of the tremendous strength of the University's GATORS Marks and Orange-and-Blue Color Mark, they are entitled to a broad scope of protection. *Tyco Healthcare Grp. LP v. Ethicon Endo-Surgery, Inc.*, 587 F.3d 1375, 1378-79 (Fed. Cir. 2009) ("Possession of a . . . strong mark entitles the possessor to broad protection for related goods.") (quoting *Times Mirror Magazines, Inc. v. Field & Stream Licenses Co.*, 294 F.3d 383, 390 (2d Cir. 2002)); *see also Avenza Sys. Inc. v. Avencia Inc.*, Cancellation No. 92046736, 2009 WL 4086592, at *11 (T.T.A.B. Sept. 29, 2009) ("The evidence is sufficient to establish that the company has achieved at least some degree of recognition and strength in the market. . . . Accordingly, we find that the mark . . . is entitled to broad protection."). Given the longstanding use of the University's GATORS Marks and Orange-and-Blue Color Mark, the volume of sales of goods and services bearing the marks, the widespread public recognition of the University's GATORS Marks and Orange-and-Blue Color Mark, and the extensive news media references using the

GATORS Marks to refer to the University, it is undeniable that the University's GATORS Marks and Orange-and-Blue Mark are strong. As a result, this factor weighs in favor of the University.

2. The Services at Issue Are Identical

The services for which the Gator Shop intends to use the GATOR SHOP Mark are identical to the retail store services and other University of Florida GATORS-related goods and services that the University offers under its GATORS Marks. This is immediately clear when one compares the language of the Gator Shop's application to that found in the University's prior registrations for its GATORS Marks and the University's common law rights in its GATORS Marks that predate the Gator Shop's alleged first use date of 1984. *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002) ("This 'relatedness of the goods' factor compares the goods and services in the applicant's application with the goods and services in the opposer's registration.").

a. The University's Incontestable Registration No. 1222098 for GATORS Claiming a Date of First Use of 1955 and Common Law Rights Cover Identical Retail Store Services

The Gator Shop seeks registration for the GATOR SHOP Mark in International Class 35 for "On-line retail store services featuring a wide variety of consumer goods of others; Retail shops featuring clothing, sports team clothing, and a wide range of consumer goods of others." These retail store services are *identical* to the services covered by the University's pleaded registrations for its GATORS Marks, specifically "Retail Store Stores, Distributorship Services and Mail Order Sales Services, in the Field of Wearing Apparel and Accessories, Novelty Items and Jewelry Class" in International Class 42 (incontestable Reg. No. 1222098 for the mark GATORS, claiming a date of first use of 1955). Opp's NOR 0001 – 0011, Ex. 1. Moreover, for decades, the University has used its GATORS Marks in connection with various on-campus retail stores, including the Gator Gift Shoppe, and has even licensed use of its GATORS Marks for retail stores. Gay Dep. at 61:19-63:14, 64:23-67:9, Exs. 43-45, 47-49; Drucker Dep. at 18:17-19:5, Ex. 6. The University also has long used its GATORS Marks in connection with online retail stores, including SHOP.GATORZONE.COM which is branded Gator Locker Room. Gay Dep. at 63:15-64:7, 64:23-65:25, Exs. 46, 48; Fincher Dep., Ex. 8.

b. The University's Numerous Pleaded Registrations and Common Law Rights Predating Applicant's Alleged First Use Date of 1984 Cover Closely Related Goods and Services

Applicant's retail store services are closely related to the apparel and entertainment services covered by the University's numerous pleaded registrations for its GATORS Marks claiming dates of first use before 1984. As discussed in Section IV.A.3, these include 6 incontestable registrations for apparel and entertainment services claiming dates of first use from as early as 1955 and before Applicant's alleged date of first use in 1984. For example, the mark GATORS (Incontestable Reg. No. 1222098) covering entertainment services, namely, conducting athletic events in Class 41, claiming a date of first use of 1955 (nearly 30 years prior to the Gator Shop's alleged first use date of 1984) and the mark GATORS (incontestable Reg. No. 2206967) covering clothing and hats in Class 25, claiming a date of first use of 1955. Opp's NOR 0001-0108, Exs. 1-12.

Since as early as the 1960s (and well before the Gator Shop's alleged first use in 1984), the University has used its GATORS Marks in connection with a broad range of apparel and merchandise. Gay Dep. at 64:23-66:13, Exs. 47-48. Since as early as the 1980s, the University has licensed use of its GATORS Marks in connection with a wide variety of apparel and merchandise, including mugs, bowls, key chains, ornaments, watches, license plate holders, playing cards, and beach towels, and also for retail stores. *Id.* at 25:16-26:7, 44:8-47:5, 57:20-60:18, 62:24-63:14, 66:14-67:9, Exs. 13, 32-33, 42, 45, 49; Drucker Dep. at 17:4-18:16, Exs. 3-5; Fincher Dep., Ex. 8.

The University has been offering entertainment services, namely, athletic events under its GATORS Marks since as early as 1955 (as shown above). The University's entertainment services are closely related to the Gator Shop's retail store services since the Gator Shop sells apparel to be worn at the University's athletic events. Fincher Dep. at 79:21-82:15, Ex. 15. The Gator Shop admits that the "sports team clothing" identified in its Application refers to the GATORS sports teams. *Id.* at 37:15-38:15, 40:3-42:9, Ex. 4. In addition, the University of Florida GATORS-branded apparel sold at the Gator Shop's retail stores are regularly worn by the fans attending the University's athletic events. Fincher Dep. at 79:21-82:15, Ex. 15; Gay Dep. at 47:6-48:13, Ex. 34.

Moreover, there is no doubt that the University's clothing, hats, and merchandise are closely related to Gator Shop's "retail shops featuring clothing, sports team clothing, and a wide range of consumer goods of others." Since as early as 1955 (as shown above), the University has been offering clothing and hats under its GATORS Marks in retail stores. In fact, the Gator Shop admits that the University's licensed products bearing its GATORS Marks have been sold in retail stores, including the Gator Shop's retail store and the University's own retail stores. Opp's NOR 0326-0487, Exs. 14-16 (Request Nos. 55 and 90). The University's retail stores and the Gator Shop's retail store even sell the same licensed products. Gay Dep. at 72:4-25; Drucker Dep. at 25:17-27:1.

"[I]t is well recognized that confusion in trade can occur from the use of similar (or the same) marks for products on the one hand and for services involving those products on the other hand." *Ultratan Suntanning Ctrs.*, 49 U.S.P.Q.2d at 1316. The Gator Shop's services - selling University of Florida GATORS-related products to fans of the University - are thus indistinguishable from the goods and services long offered under the University's GATORS Marks, and confusion is likely. *See In re Dixie Rests.*, 105 F.3d 1405, 1408 (Fed. Cir. 1997) ("If the services are identical, the degree of similarity necessary to support a conclusion of likely confusion declines.") (citation and quotation marks omitted).

3. The Parties' Marks Are Similar in Appearance, Connotation, and Commercial Impression

The test for similarity asks whether the marks, when compared in their entireties as to appearance, connotation and commercial impression, are similar in their overall commercial impressions. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005); *Starbucks U.S. Brands*, 78 U.S.P.Q.2d at 1752. This factor does not look to whether the marks may be distinguished when viewed side-by-side, but rather whether the overall commercial impression created by each mark is likely to lead to consumer confusion in the marketplace. *See, e.g., Carl Karcher Enters. v. Stars Rest. Corp.*, 35 U.S.P.Q.2d 1125, 1130 (T.T.A.B. 1995); *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 685 (C.C.P.A. 1977).

Moreover, the analysis of the marks' similarity must be made with an eye towards other of the

DuPont factors. The strength of the University's GATORS Marks is relevant here, for example, because "[a]s the [strength] of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines." *Starbucks U.S. Brands*, 78 U.S.P.Q.2d at 1750 (citation omitted). Also pertinent is the identical goods and services offered by the University and the Gator Shop under the marks at issue: "when marks appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Id.* at 1752 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992)) (quotation marks omitted).

In light of the strength of the University's GATORS Marks and identical services offered under the parties' marks (as previously discussed), a lesser degree of similarity of the marks is required to support a finding of likelihood of confusion. However, even without this reduced standard, the GATOR SHOP Mark is undoubtedly similar to the University's GATORS Marks.

The Gator Shop seeks to register the mark GATOR SHOP, which incorporates the University's GATORS mark in its entirety. While the GATOR SHOP Mark incorporates the additional term "SHOP," this term has been disclaimed (as it is descriptive of the retail store services offered under the mark) and thus fails to distinguish the GATOR SHOP Mark from the University's GATORS mark. *See* GATOR SHOP App. File. Moreover, both marks share the same dominant term: GATOR. The fact that many of the University's registrations cover the GATORS mark in its plural form (*i.e.*, GATORS), does not alter the similarity analysis. It is well-established TTAB precedent that there is no material difference between the singular and plural forms of a mark. *See, e.g., In re Pix of Am., Inc.*, 225 U.S.P.Q. 691, 692 (T.T.A.B. 1985) (noting that the pluralization of NEWPORT as NEWPORTS is "almost totally insignificant" in terms of likelihood of confusion among the purchasers); *In re Sarjanian*, 136 U.S.P.Q. 307, 308 (T.T.A.B. 1962) (finding no material difference between the singular form RED DEVIL and plural form RED DEVILS); *Wilson v. Delaunay*, 245 F.2d 877, 878 (C.C.P.A. 1957) (finding no material difference between the singular form ZOMBIE and plural form of ZOMBIES). In fact, the TTAB has held that such differences are "extremely minor and of no legal consequence." *Sarjanian*, 13 U.S.P.Q. at 308.

The GATOR SHOP Mark also conveys an identical meaning and commercial impression as the University's GATORS Marks in that it refers to the University of Florida GATORS. "A designation may well be likely to cause purchaser confusion as to the origin of goods because it conveys, as used, the same idea, or stimulates the same mental reaction, or in the ultimate has the same meaning." *Procter & Gamble Co. v. Conway*, 419 F.2d 1332, 1336 (C.C.P.A. 1970). As discussed above, the University's GATORS Marks are strong marks and consumers instantly associate the GATORS Marks with the University. Because the GATOR SHOP Mark merely affixes the descriptive term "SHOP" to the University's well-known GATORS mark, the GATOR SHOP Mark connotes a retail store operated by the University of Florida GATORS or a licensed retail store offering University of Florida GATORS-related products, which is likely to lead to confusion in the marketplace. *See, e.g., Lacoste Alligator*, 91 U.S.P.Q.2d at 1599 (finding likelihood of confusion even where the parties marks are "readily discernible as alligators or crocodiles" and applicant adds the words "Colba Island" to its mark; "[w]ith little opportunity for a side-by-side comparison and the fallibility of human recall, consumers encountering applicant's mark may mistakenly believe that applicant's clothing products are a new line for opposer").

Moreover, the Gator Shop's use of the GATOR SHOP Mark in combination with the University's GATORS Marks, Orange-and-Blue Color Mark, and other indicia of the University further reinforces the commercial effect of associating the mark with the University of Florida GATORS. Examples include: depicting the GATOR SHOP Mark with the University's Orange-and-Blue Color Mark; pictures of the University's homecoming parade, The Swamp, and GATORS football players; images of the University's GATOR Mascot; and references to Tim Tebow, the Go Gators! Cheer, and GATORS football schedules. Fincher Dep. at 40:3-42:9, 74:14-75:6, 76:10-82:15, Exs. 4, 12, 13-15; Opp's NOR 0326-0487 (Request No. 72). Even the specimen submitted in connection with the Application (which is a printout of the Gator Shop website with various captions including "Gator Shop – University of Florida Gators Apparel" and "Gator merchandise, Gator footwear") illustrates the commercial impression of the GATOR SHOP Mark is to refer to the GATORS. Fincher Dep. at 40:3-42:9, Ex. 4; Gay Dep. at 68:18-69:8, Ex. 51.

The similarities between the University's GATORS Marks and GATOR SHOP Mark as to

appearance, connotation and commercial impression – particularly when viewed in light of the strength of the University’s GATORS Marks, the identical services, and use of the GATOR SHOP Mark with various indicia of the University – are more than sufficient to suggest a likelihood of confusion. *See, e.g., Planters*, 134 U.S.P.Q. at 510 (denying applicant’s registration, noting “[t]here seems to have been no good reason why the applicant so long after the opposer had adopted and widely used its mark should have selected a mark possessing so many features similar to those of the opposer’s mark.”). There is no doubt that the parties’ marks are identical and used on identical services, which makes this an “open and shut” case: “Cases where a defendant uses an identical mark on competitive goods hardly ever find their way into appellate reports. Such cases are ‘open and shut’ and do not involve protracted litigation to determine liability” 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:20 (4th ed. 2013) (quoting *Wynn Oil Co. v. Thomas*, 839 F.2d 1183 (6th Cir. 1988)).

4. The Parties’ Channels of Trade and Customers Overlap

In cases such as this, where the applicant’s services are identical to opposer’s and there are no restrictions within the application or registration, there is an automatic presumption that the parties’ channels of trade are, or will be, identical. *See, e.g., Starbucks U.S. Brands*, 78 U.S.P.Q.2d at 1751 (“Because the parties’ respective application and registrations are unrestricted, and applicant’s goods and services are identical to some of opposer’s goods and services, we must presume that . . . the parties’ respective goods and services will be traveling through the same channels of trade to the same class of consumers.”); *Hewlett-Packard Co.*, 62 U.S.P.Q.2d at 1005.

Beyond the presumption, however, the evidence of record clearly demonstrates that both parties’ services utilize overlapping channels of trade. As discussed previously, both the University and the Gator Shop operate retail stores in and around the University’s campus. While the Gator Shop’s brick and mortar retail store closed down in March 2012, the Gator Shop continues to operate temporary tents just across the street from the University throughout the football season. Fincher Dep. at 11:1-12:15. The University and the Gator Shop also operate online retail stores at SHOP.GATORZONE.COM and

GATORSHOP.COM that serve consumers nationwide. The University and the Gator Shop sell identical products, namely, University of Florida GATORS-related products, in their retail stores. The advertising methods employed by both parties also overlap. Specifically, both advertise their marks through print and television advertising (Fincher Dep. at 71:11-74:8), Internet advertising (Fincher Dep. at 41:16-42:9, 43:21-24, Exs. 4-5), as well as promotional items such as magnets (Fincher Dep. at 76:10-24, Ex. 13). *See* Gay Dep. at 23:25-24:5, 61:4-9; Section IV.A.4. Accordingly, the parties' channels of trade are identical. *See, e.g., In re Majestic Distilling Co.*, 315 F. 3d 1311, 1316 (Fed. Cir. 2003) (finding a likelihood of confusion where the goods are marketed in the same channels of trade).

It is likewise undisputed that the parties target an identical customer base: fans, students, and alumni of the University. Drucker Dep. at 23:18-21; Gay Dep. at 67:25-68:10. Indeed, the Gator Shop admits this fact. *See* Opp's NOR 0326-0487 (Request Nos. 85-88). However, even in the absence of this admission, the Gator Shop's targeting of identical consumers is readily apparent from its own advertising:

- Q: This was a letter from the Gator Shop, it begins "Dear Student".
A: Yes.
Q: And it says, "We at Gator Shop would like to welcome you to the University of Florida." Do you see that?
A: I do.
....
Q: All right. That longer second paragraph let's call it, where it begins, "We believe the Gator Shop is going to be your best source for GATOR merchandise while you're at the university." Do you see that?
A: Uh-huh.
Q: Yes?
A: Yes, I do.
Q: It says, "We carry an extensive line of GATOR sportswear." By GATOR sportswear, is that a reference to the University of Florida?
A: Yes.
Q: Next paragraph, excuse me, it says, "From infant to adult, double extra large sizes, incorporating numerous University of Florida logos." Do you see that?
A: Yes, I do.
Q: And that's true generally in terms of your merchandise?
A: Yes.
Q: At the very end of that paragraph, it says, "In other words, if it's orange and blue and says GATORS, we carry it."
A: I see that.
Q: I know it's a little advertising puffery, but is that generally true?
A: Yeah, that's generally true.
Q: All right. This also references the fact, in the next paragraph, that the Gator Shop is directly across from the university. Do you see that?

A: Yes, I do.

....

Fincher Dep. at 55:10-58:17, Ex. 9. The Gator Shop's advertising, including its direct mailings, email blasts, catalogs, solicitations, website, ads in the University's alumni magazine, and ads in the University's student newspaper - all use the University's GATORS Marks, the Orange-and-Blue Color Mark, and other indicia of the University to target the same customers as the University. *See* Section IV.C. The fact that the parties' products are sold in the same channels of trade to the same customers confirms that confusion is likely and, thus, this factor weighs in favor of the University.

5. Actual Confusion Between Applicant's GATOR SHOP Mark And the University's GATORS Marks

Although evidence of actual confusion is not necessary to prove likelihood of confusion, it is the most probative evidence possible:

This evidence of actual confusion is quite persuasive of the likelihood of confusion since there can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion especially in view of the fact that evidence of actual confusion, much less competent evidence of such confusion, is difficult to come by.

Finance Co. of Am. v. BankAmerica Corp., 205 U.S.P.Q. 1016, 1035 (T.T.A.B. 1980). Unlike the vast majority of cases where no evidence of actual confusion exists, the evidence of record contains instances of actual confusion between the parties' marks, which should be considered by the Board and given substantial weight in the likelihood of confusion analysis. Specifically, the Gator Shop's Rule 30(b)(6) designee and the owner of the Gator Shop testified as to the actual confusion caused by the Gator Shop's misappropriation of the University's GATORS Marks:

Q: Do you recall situations in which people tried to return licensed UF merchandise and they didn't have a receipt or you were pretty sure they didn't buy it from you?

A: I have had people come in. I'll give you a good for instance. A lady told me she just bought it at the stadium store. Because they didn't have a 6X, she comes over to my store, looks and sees that I have a 6X and wants to trade it with me, her 6 for my 6X. I said I can't do that. Well, it's the same thing, and you're both University of Florida. I said, I'm not the University of Florida, okay. And let me ask you a question. If you bought a lawnmower at Home Depot, would you try to take it back to Lowe's? No, of course not. I said, well, why are you trying to do it now?

....

Q: We talked about the instance in which someone had bought something at the university store and tried to swap it out at your store to get a different size. Were there other conversations, maybe not involving product swaps or returns, but in which customers asked you if you were affiliated with the university or part of the university or the same as the bookstore or something like that?

A: Not -- not affiliated with the university. I have had customers ask me if the university was affiliated with me... I have had numerous people call up and say I want to return item number, it wasn't what I thought it was. I'm like what item number, 227, or whatever. And we kept the University of Florida's catalog, because when we didn't have the merchandise, we would immediately look in the University of Florida, and it would normally be one of their items. And they would go, but you're the Gator Shop, right? Yes, we are. Well, then why is the University of Florida using the name the Gator Shop? And I said, well, it's the Gator Sports Shop, it's not the Gator. So they were creating a confusion between our name and their name...

Fincher Dep. at 64:1-25, 88:16-25, 89:1, 89:16-25, 90:1-3 (emphasis added). Applicant thus admitted that “people” have been confused into believing that the Gator Shop is affiliated with the University. Such credible evidence of actual confusion warrants a finding of liability. *See Kos Pharm., Inc. v. Andrx Corp.*, 369 F.3d 700, 720 (3d Cir. 2004) (finding that even “anecdotal evidence of confusion” is so rare that it “makes even a few incidents ‘highly probative of the likelihood of confusion.’”); *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 489 (5th Cir. 1971) (holding “very little proof of actual confusion would be necessary to prove likelihood of confusion”) (emphasis added).

6. The Gator Shop Adopted Its Mark With Knowledge of The University’s Rights in Its GATORS Marks and With The Intent to Trade Off The Goodwill Associated with The University’s GATORS Marks

The intent of the party adopting the mark is an important factor in determining whether there is a likelihood of confusion. *See, e.g., TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1473 (Fed. Cir. 1997).

Evidence that an applicant adopted its mark with the intent to trade on the goodwill of the prior user is probative of a likelihood of confusion and weighs against allowing registration of the mark. *See, e.g., Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1013 (C.C.P.A. 1979). Indeed, “[a] mark designed to maximize association between entities, as here, is likely to lead to confusion.” *Id.*

Applicant was well aware of the University’s GATORS Marks before adopting its GATOR SHOP Mark. Joe Fincher, the owner of the Gator Shop, admitted to having knowledge of the University and its GATORS Marks since as early as 1972 (nearly a decade before adopting the GATOR SHOP Mark

in 1984). Fincher Dep. at 7:2-15, 23:20-24:3. Mr. Fincher also admitted that the GATORS Marks were strong and that the University owned the GATORS Marks in connection with “a lot of things.” *Id.* at 23:20-24:3, 25:4-10. Nevertheless, the Gator Shop proceeded with its application to register the GATOR SHOP Mark, seemingly in hopes of avoiding the University’s licensing requirements, while simultaneously riding on the coattails of the goodwill the University has built in its GATORS Marks. The Gator Shop’s attempt to avoid the University’s licensing requirements is particularly egregious in light of Mr. Fincher’s 25 years of prior experience representing licensed manufacturers of collegiate products and his actual knowledge and awareness of the University’s licensing program. Fincher Dep. at 7:2-9:11, 25:4-26:14. The Gator Shop’s intent to adopt a mark that trades on the goodwill of the University’s GATORS Marks is reinforced by its use of the GATOR SHOP Mark in combination with the University’s registered GATORS Marks, Orange-and-Blue Color Mark, and other indicia of the University. *See* Section IV.C.

The present case is analogous to several cases involving college trademarks and attempts to trade off of the goodwill of those trademarks. In *Smack Apparel*, the plaintiff universities (Louisiana State University, Ohio State University, University of Oklahoma, and University of Southern California) alleged that the defendants engaged in unfair competition and trademark infringement by selling shirts bearing the distinctive color Marks used by the universities, along with other symbols or references that identify the universities. 438 F. Supp. 2d at 661. Because the defendants used the universities’ color schemes, logos, and designs with “an intent” to “rely upon the drawing power” in enticing fans of the particular universities to purchase their shirts, the court found the defendants had the intent to trade off the goodwill of the universities’ trademarks and this factor weighed in favor of a likelihood of confusion. *Id.* Similarly, in *University of Kansas v. Sinks*, the University of Kansas (“KU”) sued a manufacturer and retailer of t-shirts bearing various marks and indicia of KU, including its Crimson and Blue Color Mark, alleging trademark infringement and unfair competition. 565 F. Supp. 2d 1216, 1247-48 (D. Kan. 2008). The court found there was substantial evidence that the defendant intended to trade off the goodwill of KU’s marks, noting the following:

But the record is clear that defendants intended to reference KU in their products. The products are sold at a retail store in the town where KU's main campus is located, entitled "JoeCollege.com." Most of the allegedly infringing shirts portray various marks and images on shirts in KU's official colors of crimson and blue that, as a whole, clearly reference KU. Defendant Sinks was familiar with the licensing process at KU; had sought a license and was denied.

Id. In all of these cases, the defendants were aware of the universities' marks and used the universities' marks with the intent to trade on the goodwill of the universities. Here, like in *Smack Apparel* and *Sinks*, the Gator Shop had full knowledge of the University, its GATORS Marks, and the University's licensing program well prior to its adoption of the GATOR SHOP Mark. The Applicant adopted the GATOR SHOP Mark because it traded on the University's GATORS Marks (as Applicant's Rule 30(b)(6) designee testified, the GATOR SHOP Mark was a "good location, good name"). Fincher Dep. at 22:15-23:19. While the Gator Shop does not manufacture any products, the Gator Shop operates a retail store selling University of Florida GATORS-branded products to fans of the University. The Gator Shop also intentionally uses the GATOR SHOP Mark in combination with the University's GATORS Marks, Orange-and-Blue Color Mark, and various indicia of the University to purposefully and unlawfully trade on the "drawing power" of the University's trademarks. Such intent to trade on the goodwill of the University's GATORS Marks is strong evidence of a likelihood of confusion, and this factor weighs in favor of the University.

7. Any Doubt Must be Resolved Against the Gator Shop

Any doubts regarding the existence of a likelihood of confusion must be resolved in favor of the prior user, in this case the University:

The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, that there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises 'but one inference – that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark,' and that all doubts as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 676 (Fed. Cir. 1984) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 924 (C.C.P.A. 1962)); see also *In re Mighty Leaf*

Tea, 601 F.3d 1342, 1346 (Fed. Cir. 2010) (“As applied to trademark registration, reasonable doubt as to the likelihood of confusion is resolved against the newcomer, for the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so.” (internal citations and quotation marks omitted)); *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 355 (Fed. Cir. 1992); *Miss Universe L.P. v. Cmty. Mktg., Inc.*, 82 U.S.P.Q.2d 1562, 1572 (T.T.A.B. 2007). To the extent the Board has any doubt about the likelihood of confusion, it should be resolved against the Gator Shop.

D. The Gator Shop Mark Falsely Suggests a Connection With the University in Violation of Section 2(a) of the Lanham Act

Under Section 2(a) of the Lanham Act, a mark shall be refused registration if it “[c]onsists of or comprises ... matter which . . . falsely suggest a connection with persons, living or dead, [or] institutions.” 15 U.S.C. § 1052(a). The GATOR SHOP Mark should be refused registration under Section 2(a) because it falsely suggests a connection with the University.

A Section 2(a) claim has its roots in the rights of privacy and publicity, *i.e.*, a right to control use of one’s identity. *See In re White*, 73 U.S.P.Q.2d 1713, 1718 (T.T.A.B. 2004). A Section 2(a) claim for false suggestion of a connection requires proof of the following elements:

- (1) that opposer is not connected with the goods sold or the activities performed by applicant under the mark;
- (2) the applicant’s mark is the same as, or a close approximation of, the opposer’s previously used name or identity;
- (3) that applicant’s mark would be recognized as such, in that it points uniquely and unmistakably to opposer; and
- (4) that opposer’s name or identity is of sufficient fame or reputation that, when the applicant’s mark is used on its goods or services, a connection with the opposer would be presumed.

See, e.g., Buffett v. Chi-Chi’s, Inc., 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985). All four elements confirm the GATOR SHOP Mark falsely suggests a connection with the University.

First, the University has never licensed use of its GATORS Marks to the Gator Shop. Fincher Dep. at 29:15-22; Drucker Dep. at 26:5-12; Gay Dep. at 69:9-16. The Gator Shop's use of the University's GATORS Marks is hence unauthorized and unlicensed. *See id.*

Second, the GATOR SHOP Mark is virtually identical to the University's GATORS Marks. As discussed in Section V.C.3, the GATOR SHOP Mark incorporates the University's GATORS mark *in its entirety*. The only additional term "SHOP" has been disclaimed and thus fails to distinguish the mark from the University's GATORS Marks. Moreover, the University's well-known GATORS mark is the dominant component of the GATOR SHOP Mark.

Third, the GATOR SHOP Mark points uniquely and unmistakably to the University. As discussed in Sections IV.C and V.C, the GATOR SHOP Mark incorporates the University's well-known GATORS mark *in its entirety* for identical services offered by the University. In fact, the Gator Shop adopted the GATOR SHOP Mark because it referred to the University of Florida GATORS. The Gator Shop logo, which is prominently displayed on its website at GATORSHOP.COM, and on the specimen submitted in connection with the Application, incorporates the University's Orange-and-Blue Color Mark. Opp's NOR 0326-0487 (Request No. 43). All of the Gator Shop's advertising materials, product catalogs, website, and mailings offered under the GATOR SHOP Mark misappropriate the University's trademarks and other indicia of the University to purposefully associate the GATOR SHOP Mark with the University. The undisputed evidence is overwhelming that the GATOR SHOP Mark, particularly in the light of how the Gator Shop seeks to use the GATOR SHOP Mark (*i.e.*, a retail store offering University of Florida GATORS-related products), points uniquely and unambiguously to the University. *See, e.g., In re Urbano*, 51 U.S.P.Q.2d 1776, 1779 (T.T.A.B. 1999) (finding the mark SYDNEY 2000 pointed unambiguously to the Olympic Games held in Sydney in 2000 and thus falsely suggested a connection with the organizations that conduct the Olympic Games); *In re Sauer*, 27 U.S.P.Q.2d 1073, 1074-75 (T.T.A.B. 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994) (refusing registration of the mark BO BALL and design since purchasers would make a connection between the famous football and baseball athlete, Bo Jackson, and the applicant's goods).

Finally, the University's GATORS Marks are so well-known that when the GATOR SHOP Mark is used on identical goods and services, a connection with the University is presumed. *See Bd. of Trs. of the Univ. of Ala. v. BAMA-Werke Curt Baumann*, 231 U.S.P.Q. 408, 411 (T.T.A.B. 1986) (finding the word BAMA is a well-known nickname for the University of Alabama and its football team and that unauthorized use of the identical goods misappropriates the identity of and falsely suggests a connection with the University). Here, the University has used its GATORS Marks for over a century in connection with a wide variety of goods and services related to the University, including retail store services, and well prior to the Gator Shop's adoption of the GATOR SHOP Mark. Through longstanding, expansive, and continuous use, the University's GATORS Marks have become well-known. *See* Section V.C.1.

The Gator Shop's retail store services under the GATOR SHOP Mark are identical to the retail store services offered by the University under its GATORS Marks. *See* Section V.C.2. For decades, the University has sold University of Florida GATORS-related products in brick and mortar retail stores and online retail stores. When the GATOR SHOP Mark is used on identical services as those offered by the University, the GATOR SHOP Mark is presumed to falsely suggest a connection with the University. *See, e.g., In re White*, 73 U.S.P.Q.2d at 1718 (finding that the mark APACHE is widely known and its use on the applicant's goods which were identical to the opposers' goods created a presumption that applicant's mark falsely suggested a connection with the opposers); *In re Urbano*, 51 U.S.P.Q.2d at 1779 (presuming a connection with the Olympic Games where the applicant's SYDNEY 2000 mark is used in connection with identical goods).

Therefore, registration of the GATOR SHOP Mark should be refused because it falsely suggests a connection with the University in violation of Section 2(a).

VI. CONCLUSION

The GATOR SHOP Mark, if registered, would create a likelihood of confusion, mistake, or deception as to the University's GATORS Marks and would create a false sense of affiliation with the University, and would injure both the University and the consuming public. For these and the reasons expressed above, the University respectfully requests that this opposition be sustained and registration of

the GATOR SHOP Mark be refused.

Dated: January 16, 2014

Respectfully submitted,

/Rosaleen H. Chou/

R. Charles Henn Jr.

Rosaleen H. Chou

KILPATRICK TOWNSEND & STOCKTON LLP

1100 Peachtree Street

Suite 2800

Atlanta, Georgia 30309-4530

(404) 815-6500

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S TRIAL BRIEF was served on counsel for Applicant on January 16, 2014 via first class mail to:

Sven W. Hanson, Esq.
PO Box 357429
Gainesville, Florida 32635-7429

/Rosaleen H. Chou/
Rosaleen H. Chou
Attorney for Opposer

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing OPPOSER'S TRIAL BRIEF is being filed electronically with the TTAB via ESTTA on this day, January 16, 2014.

/Rosaleen H. Chou/
Rosaleen H. Chou
Attorney for Opposer